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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,446	01/20/2004	Marc R. Laviana		3051

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EXAMINER

BELL, KENT L

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/761,446

Applicant(s)

LAVIANA, MARC R.

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on application filed 1/20/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/~~are~~ pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/~~are~~ withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/~~are~~ allowed.
- 6) ☒ Claim(s) 1 is/~~are~~ rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/~~are~~ objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/20/04 is/~~are~~: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

K. L. Bell

**Detailed Action**

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

### **Detailed Action**

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if

the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, line 17, Applicant states "(U.S. patent no. PP12,720)". Rather than stating "(U.S. patent no. PP12,720)" applicant should state --(U.S. Plant Patent No. 12,720)-- to clearly set forth that the U.S. Patent being referred to is a U.S. Plant Patent.

B. Page 3, line 23, Applicant should place a single quotation mark after "Gate".

C. Page 4, line 4, Applicant sets forth a stem size but does not state whether the dimension set forth is for the length, diameter, or other. Applicant should set forth in the specification the typical and observed stem length and diameter.

**Detailed Action**

D. Page 4, lines 10-12 and lines 20 and 21, Applicant states leaves are divided into three linear leaflets. However, it is unclear from the photographic illustrations that this is accurate. It may be the leaves are actually deeply lobed. Applicant should verify whether the leaves are compound and divided into three leaflets or simply lobed.

E. Page 4, line 11, Applicant states "occasionally entire". This recitation is not understood as it is unclear what applicant is intending since applicant states "leaflet margins are entire". Correction and/or clarification is necessary.

F. Page 4, line 24, Applicant states "Campitulum". It appears applicant may have intended to state --Capitulum--. Correction and/or clarification is necessary.

G. Page 4, lines 24 and 28 and page 6, line 4, "disk" and "Disk" should be spelled as --disc-- and --Disc-- respectively.

H. Page 4, lines 27 and 28 and page 6, line 4, Applicant states "flowers". It appears --florets-- would be the more appropriate term to use in these instances.

**Detailed Action**

I. Page 5, line 1, Applicant states “9 mm in length” and sets forth a diameter. It appears applicant may have intended to state 9 mm in --height-- or --depth-- or something else.

Correction and/or clarification is necessary. Applicant should set forth in the specification the typical and observed inflorescence depth.

J. Page 5, lines 7-15, Applicant states “Involucral bracts”. Rather than stating this recitation it appears --Phyllaries-- would be the more proper botanical term to use especially as the instant plant is a composite.

K. Page 5, line 9, Applicant states “depth”. It appears applicant may have actually intended to state --length--. Correction and/or clarification is necessary.

L. Page 5, lines 11 and 12, Applicant sets forth colorations for the instant plant’s bracts (phyllaries). However, applicant has not stated whether the colorations set forth are for the upper, lower, or both surfaces. Applicant should set forth in the specification colorations for the upper and lower surfaces with reference to the employed color chart.

**Detailed Action**

M. Page 5, lines 14 and 15, Applicant should set forth in the specification additional information relative to the instant plant's bracts (phyllaries) including the typical and observed bract (phyllary) margin and base descriptors.

N. Page 5, line 31, Applicant states "petal". Rather than stating petal it appears --ray floret-- would be the more appropriate term to use in this instance.

O. Page 6, lines 4-10, Applicant should set forth in the specification additional information relative to the instant plant's disc florets including the diameter of the entire disc.

P. Page 6, line 12, Applicant should review the reproductive organs on both ray and disc florets and set forth in the specification where the Gynoecium and Androecium are located.

Q. Page 6, line 16, "Androcoecium" should be spelled as --Androecium--. Correction and/or clarification is necessary.

R. Page 6, line 18, Applicant sets forth a diameter and a width. It is not understood why applicant sets forth a diameter if the fruit is flat. It appears a length and width would be more

**Detailed Action**

appropriate. Applicant should set forth in the specification the typical and observed fruit length. Further, applicant should verify that achene is used properly to describe the type of fruit.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.



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### **Detailed Action**

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

**KENT BELL  
PRIMARY EXAMINER**

*Kent L. Bell*